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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,067	02/13/2004	Naoki Tsuchiya	Q79844	5628

23373 7590 03/06/2006
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT PAPER NUMBER

1626

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/777,067

Applicant(s)

TSUCHIYA ET AL.

Examiner

Laura L. Stockton, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/169,866.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/13/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claims 1-16 are pending in the application.

Election/Restrictions

Applicants' election of the group (i.e., scope of the elected invention) of products of formula (I) wherein R^1 and R^2 do not together form a ring; X is CH=; M is $S(O)_m$, J is a substituted or unsubstituted benzothiophene ring; an E is $COOR^3$ (and the species of Example 54 found on page 17 of the specification), in the reply filed on December 9, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The requirement is still deemed proper and is therefore made FINAL.

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Subject matter not embraced by the above scope of the elected invention and Claim 6 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions. Election was made **without** traverse in the reply filed on December 9, 2005.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 10/169,866, filed on July 10, 2002.

Information Disclosure Statement

The Examiner has considered the Information Disclosure Statement filed on February 13, 2004.

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Claim Objections

Claims 7-11 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n).

Claims 12 and 13 have been interpreted as compound claims since no other ingredient is recited in the claims. Therefore, Claims 12 and 13 are objected to for being substantial duplicates of claim 1. When two claims in an application are duplicates, or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to reject the other as being a substantial duplicate of the allowed claim. M.P.E.P. §706.03(k).

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Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13, 15 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In In re Wands, 8 USPQ2d 1400 (1988), factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. § 112, first paragraph, have been described. They are:

1. the nature of the invention,
2. the state of the prior art,

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3. the predictability or lack thereof in the art,
4. the amount of direction or guidance present,
5. the presence or absence of working examples,
6. the breadth of the claims,
7. the quantity of experimentation needed, and
8. the level of the skill in the art.

The nature of the invention

Applicants are claiming a pharmaceutical composition which is a preventive agent or a therapeutic agent of numerous diseases and disorders by administering a composition comprising a compound of formula (1). See, for example, instant claim 16. From the reading of the specification, it appears that Applicants are asserting that the embraced compounds, because of their mode action which involves the inhibition of human chymase, would be useful for preventing or treating numerous diseases and disorders such as an inflammatory disease, etc.

***The state of the prior art and the predictability
or lack thereof in the art***

Cancer is considered an inflammatory disease. The state of the prior art is that cancer therapy, for example, remains highly unpredictable. The various types of cancers have different causative agents, involve different cellular mechanisms, and consequently, differ in treatment protocol. It is known (see Golub et al., Science, Vol. 286, October 15, 1999, pages 531-537) that the challenge of cancer treatment has been to target specific therapies to pathogenetically distinct tumor types, to maximize efficacy and minimize toxicity. Cancer classification has been based primarily on morphological appearance of the tumor and that tumors with similar histopathological appearance can follow significantly different clinical courses and show different responses to therapy (Golub et al., Science, Vol. 286, October 15, 1999, pages 531-537). There is no absolute

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predictability even in view of the seemingly high level of skill in the art. The existence of these obstacles establishes that the contemporary knowledge in the art would prevent one of ordinary skill in the art from accepting any therapeutic regimen on its face.

Additionally, for example, inflammation is a process that can take place in virtually any part of the body. There is a vast range of forms that it can take, causes for the problem, and biochemical pathways.

The amount of direction or guidance present and the presence or absence of working examples

There is no evidence of record, which would enable the skilled artisan in the identification of the people who have the potential of becoming afflicted with the numerous diseases or disorders claimed herein. That a single class of compounds can be used to prevent or treat all diseases embraced by the claims is an incredible finding for which Applicants have not

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provided supporting evidence. Applicants have not provided any competent evidence or disclosed tests that are highly predictive for the pharmaceutical use for preventing or treating all conditions by administering the instant claimed compositions containing a compound of formula (1).

The breadth of the claims

The breadth of the claims is a composition comprising a compound of formula (1) for preventing or treating of all diseases and disorders generically embraced in the claim language.

The quantity of experimentation needed

The nature of the pharmaceutical arts is that it involves screening in vitro and in vivo to determine which compounds and compositions exhibit the desired pharmacological activities for each of the diseases and disorders instantly claimed. The quantity of experimentation needed would be undue when faced with the lack of direction and guidance present in the

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instant specification in regards to testing all diseases and disorders generically embraced in the claim language, and when faced with the unpredictability of the pharmaceutical art. Thus, factors such as "sufficient working examples", "the level of skill in the art" and predictability, etc. have been demonstrated to be sufficiently lacking in the instant case for the instant method claims.

The level of the skill in the art

Even though the level of skill in the pharmaceutical art is very high, based on the unpredictable nature of the invention and state of the prior art and lack of guidance and direction, one skilled in the art could not use the claimed invention without undue experimentation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 and 7-16 are rejected under 35

U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, under the definition of variable A, the expression "alkenylene group having 1-7 carbon atoms" makes the claim indefinite because an "alkenylene" group must have a minimum of two carbons.

In claim 15, it is not possible to "prevent" and "treat".

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29

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USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 and 7-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10, 14, 29 and 30 of copending Application No. 10/474,334; claims 15, 16, 18, 19, 21 and 23-31 of copending Application No. 10/963,710; and claims 1-3, 5-7, 9 and 11-17 of copending Application No. 11/129,508. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is an overlap of the subject matter being claimed in each of the applications.

The indiscriminate selection of "some" among "many" is *prima facie* obvious, In re Lemin, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g., human chymase inhibitory activity).

One skilled in the art would thus be motivated to prepare compounds embraced by Application No. 10/474,334, 10/963,710 and 11/129,508 to arrive at the instant claimed compounds with the expectation of obtaining additional beneficial compounds which would be useful in treating, for example, inflammation. The instant claimed invention would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-3 and 7-16 are rejected under 35 U.S.C. 102(a) as being anticipated by Matsumoto et al. {CA 2,336,909}.

Matsumoto et al. disclose, for example, compounds 455, 459, etc. on pages 34, 2, 13 and 15 in Table 19, which are embraced by the instant claimed invention. Also see pages 63-66.

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Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5 and 7-16 are provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. 10/963,710 which has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the copending

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application, it would constitute prior art under 35 U.S.C. 102(e) if published or patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future publication or patenting of the conflicting application.

The instant application claims benzimidazole compounds. Application No. 10/963,710 discloses and claims benzimidazole compounds that are either structurally the same as or structurally similar to the instant claimed compounds.

For example, see pages 2-5 and 63-66; the Tables starting at page 16; and specifically, compounds 455, 459, etc. on page 34 in the specification of Application No. 10/963,710.

The indiscriminate selection of "some" among "many" is *prima facie* obvious, In re Lemin, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar

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compounds would possess similar activity (e.g., human chymase inhibitory activity).

One skilled in the art would thus be motivated to prepare compounds embraced by Application No. 10/963,710 to arrive at the instant claimed compounds with the expectation of obtaining additional beneficial compounds which would be useful in treating, for example, inflammation. The instant claimed invention would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art.

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the

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copending application under 37 CFR 1.131. For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(1)(1) and § 706.02(1)(2).

Claims 1-5 and 7-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al. {CA 2,336,909}.

Determination of the scope and content of the prior art (MPEP §2141.01)

Applicants claim benzimidazole compounds. Matsumoto et al. teach benzimidazole compounds that are either structurally the same as (see above 102 rejection) or structurally similar to the instant

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claimed compounds. See, for example, pages 2-5 and 63-66; the Tables starting at page 16; and specifically, compounds 455, 459, etc. on page 34.

***Ascertainment of the difference between the prior art and the claims
(MPEP §2141.02)***

The difference between some of the compounds of the prior art and the compounds instantly claimed is that the instant claimed compounds are generically described in the prior art.

***Finding of prima facie obviousness--rational and motivation (MPEP
§2142-2413)***

The indiscriminate selection of "some" among "many" is *prima facie* obvious, In re Lemin, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g., a human chymase inhibitory activity).

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One skilled in the art would thus be motivated to prepare compounds embraced by the prior art to arrive at the instant claimed compounds with the expectation of obtaining additional beneficial compounds which would be useful in treating, for example, inflammation. The instant claimed invention would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art.

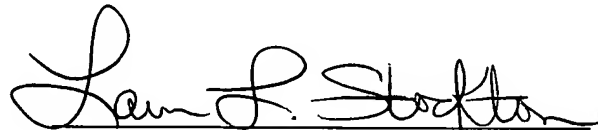
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private

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PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

A handwritten signature in black ink, appearing to read "Laura L. Stockton". The signature is fluid and cursive, with the first name "Laura" and last name "Stockton" clearly distinguishable.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

February 23, 2006